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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,489	03/08/2001	Isao Iwaguchi	1081.1111/JDH	2199
21171 7590 05/21/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER LUDWIG, PETER L	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/800,489

Applicant(s)

IWAGUCHI ET AL.

Examiner

Peter L. Ludwig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 16 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 16 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This Office Action has been given Paper No. 20070503 for reference purposes only.
2. This Office Action is in correspondence to the Amendment filed on 02/20/2007.
3. Claims 9, 11, 16, and 22-26 are currently pending. Claims 1-8, 10, 12-15, and 17-21 have been canceled by Applicant. Claims 22-26 are new to the application.

Response to Arguments

4. Applicant's arguments have been fully considered and are moot in view of the grounds of rejection. With regards to Applicant's argument about whether or not Komai teaches or suggests the sending of the electronic receipt in response to a prompt of a settlement key of the store settlement device, as is provided in the present invention, as taught below, the limitation is rejected based on the §103(a) rejection. With regards to the arguments on the §102(b) rejection, the Examiner has withdrawn the rejection and turned it into a §103(a) rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9, 11, 16 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 6,487,540 B1) in view of Komai (US 6,625,579 B1), and further in view of Applicant's own admissions.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 9, 11, 16 and 22-26:

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With regard to the limitations of:

- *calculating goods settlement information from goods information of goods purchased by a user and processing a settlement;*
- *sending goods purchase information, including said goods settlement information, to a mobile terminal of said user, and storing the goods purchase information in said mobile terminal to communicate with a processing device of said user,*
- *reading the goods information for the goods purchased by said user using a reader on said settlement device;*
- *calculating the goods settlement information from said read goods information on a register terminal of said settlement device and processing the settlement;*
- *transfers the goods purchase information from the memory into a household budget system of said processing device of said user;*

See at least Column 2, lines 11-20; column 3, lines 19-26, lines 31-36, lines 45-55; and column 5, lines 47-51; Column 1, lines 7-20. The use of the Wireless Application Protocol (WAP) in this case reads on Applicants use of a prompt between units to signal transfer of data. The Examiner is interpreting the use of the transmission of the electronic receipt from a vendor device to a user device to management and accounting software as reading on the "household budget system" of the newly added claims. The Examiner is interpreting the "household budget system" as accounting software, such as Quicken.

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Smith does not specifically disclose a settlement key or a receipt issue key.

Komai, however, in at least column 6, line 16 as well as column 11, line 51 does. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Smith and Komai because each reference common POS architectures known at the time of the instant invention.

Smith does teach the storing of the goods purchase information in storage in at least Fig. 1, Column 5, and lines 1-25 and Komai does teach in response to the prompt from the settlement key of said goods settlement information, in at least column 6, line 16. Smith does not specifically disclose the mobile terminal temporarily storing the goods purchase information in a memory. Komai, however, in at least col. 8, lines 5-10 does disclose the temporary storage of data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Komai with Smith for the useful purpose of being able to remove the data when it is either obsolete or not needed, to save space on the computer with a limited amount of space.

With regard to the limitation of wherein said sending of the goods purchase information comprises sending said goods purchase information to said mobile terminal from said register terminal in response to a prompt from a settlement key of said goods settlement information in said register terminal. Applicant, in the background of the specification, discloses that the processes between users and POS terminals are already well known and widely used during a transaction.

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With regard to the limitations of:

- *requesting said goods purchase information from said reader to said register terminal.*
- *receiving said goods purchase information from said register terminal to said reader.*
- *sending said received goods purchase information to said terminal from said reader.*
- *sending a send enable signal to said mobile terminal from said reader when said reader reads a barcode of said goods;*
- *transmitting a received request to said reader from said register terminal in response to said send enable signal, and*
- *requesting said goods purchase information from said reader to said register terminal in response to said receive request;*

See at least Column 2, lines 11-20; column 3, lines 19-26, lines 31-36, lines 45-55; and column 5, lines 47-51. The use of the Wireless Application Protocol (WAP) in this case reads on Applicants use of a prompt between units to signal transfer of data. In addition, see the inclusion of the Applicant's background information regarding POS terminals.

7. Claims 3, 9, 11, 16 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al. (US 2003/0132298 A1) in view of Smith, and further in view of Applicant's own admissions.

Claims 9, 11, 16 and 22-26:

Swartz discloses a self-checkout system that utilizes bar code readers to tally purchase items at a merchant shop and then uses a PDA to permit the checkout of the customer with the items, the transaction having been settled and complete.

As Applicant argues, Swartz does not disclose a POS terminal, apart from the mobile terminal, that includes a scanner. However, Smith does teach POS terminal that includes a scanner, at least in col. 5, lines 34-54. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the workings of Smith with Swartz for the useful purpose of having another means for transmitting and receiving product and transaction information and transmit electronic receipt information, as taught by Smith.

As per the newly added claims of 22-24, Swartz teaches transferring the information to a localized computer of the merchant so that the merchant can access all of the data associated with a customer and market products to said customer based on the information, but Swartz does not teach wherein the information may be transmitted to a household system of the customer. However, Smith does teach this, at least in Column 1, lines 7-20. Therefore, it would have been obvious to one of ordinary skill in the art at the

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time of the invention to combine Smith with Swartz for the useful purpose of tracking transaction history for accounting/tax purposes.

Claim Interpretations

8. With respect to the pending claims, the Examiner respectfully reminds Applicants that: “A system is an apparatus.” *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993)(citations omitted). Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner’s position that Applicants’ system claims are “product,” “apparatus,” or more specifically, “machine” claims.¹

9. In light of Applicants’ choice to pursue product claims, Applicants are also reminded that functional recitations using the word “for,” “configured to,” or other functional terms (*e.g.* see claim 25 which recites “a second communication unit for”) have been considered but are given little patentable weight² because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However a recitation of the intended use in a product claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

¹ Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a).

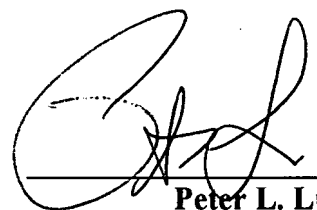
² See *e.g. In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight.).

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Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

 5/07/2007

Peter L. Ludwig
Patent Examiner
Art Unit 3621


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